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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,465	07/26/2001	Michael Wayne Brown	AUS920010393US1	7021

43307 7590 04/21/2005		EXAMINER
IBM CORP (AP)		PHILLIPS, HASSAN A

ART UNIT	PAPER NUMBER
2151	

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DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 March 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments and remarks filed on March 1,

2005.

Specification

2. The Examiner has received and considered the amendments made to the

specification to update the status of the cited applications. After consideration of the

amendments the Examiner has withdrawn the objection to the specification.

Response to Arguments

3. Applicant's arguments with respect to claims 1-30, have been fully considered

but they are not persuasive. Applicant argued that:

A) The Examiner does not address the limitation "in response to channel options

for said messaging session allowing editing by said particular user", and instead cites a

passage that describes hashing tables with hash codes calculated for data objects to

uniquely identify each object on a "White Board";

B) There is no suggestion to modify the teachings of Simonoff; and

C) Simonoff teaches modifying data objects, and not chat text.

4. In regards to A), Examiner respectfully submits that the wrong passage was

cited in considering the claims. The correct passage that reads over the claimed

invention is col. 18, lines 12-31, instead of col. 19, lines 12-31. Examiner further notes

that particular columns and line numbers cited in the references are applied to the

claims for the convenience of the applicant. Although the specified citations are

representative of the teachings of the art and are to be applied to specific limitations

within the individual claim, other passages and figures may apply as well. In preparing

responses, Applicant should always fully consider the references in their entirety as

potentially teaching all or part of the claimed invention, as well as the context of the

passage as taught by the prior art or disclosed by the Examiner.

Furthermore, the limitation "in response to channel options for said messaging

session allowing editing by said particular user" is implicit in the teachings of Simonoff

since users may or may not have privileges to view a message to edit, (col. 18, lines

12-31).

5. In response to B), the examiner recognizes that obviousness can only be

established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

motivation is found in the knowledge generally available to one of ordinary skill in the

art. Digital signatures and submitting editing requests, if not implicit in the teachings of

Simonoff, were well known in the art at the time of the present invention.

6. In regards to C), Examiner respectfully submits that the Applicant has

misinterpreted the teachings of the prior art. Simonoff teaches data objects being

associated with chat sessions amongst users, (col. 17, lines 39-59). Simonoff further

teaches that users can modify chat text **within the data object** when participating in a

chat session, (col. 17, lines 39-59, and col. 18, lines 12-31).

7. Applicant's remaining arguments with respect to claims 1-30, have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Simonoff U.S. Patent 6,463,460, in view of Gupta et al., (hereinafter Gupta), U.S. Patent

Pub. No. 2002/0099777, (previously made of record and not relied upon).

10. In considering claims 1, 9, and 16, Simonoff teaches a method, system and

program for recording a messaging session, all comprising a means for: Enabling a

particular user to edit a particular messaging entry from among a plurality of message

entries previously submitted in a messaging session, wherein at least one other user

has participated in said messaging session with said particular user, wherein said

messaging session facilitates said plurality of message entries during chat

communication between said particular user and said other user, (col. 17, lines 39-59,

and col. 18, lines 12-31); and, saving said edit to said messaging entry as a final record

of said messaging session, such that said particular user is enabled to edit said

messaging session prior to saving said final record, (col. 17, lines 39-59, col. 18, lines

12-31, and col. 25, lines 25-37).

Although the teachings of Simonoff show substantial features of the claimed

invention, they fail to expressly disclose: editing a particular messaging entry in a first

record.

Nevertheless, in a similar field of endeavor, Gupta teaches a method for

recording a messaging session, comprising: enabling a particular user to edit a

particular messaging entry in a first record of a plurality of message entries previously

submitted in a messaging session, wherein at least one other user has participated in

the messaging session with the particular user, wherein the messaging session

facilitates the plurality of message entries during chat communications between the

particular user and the other user, (page 10, paragraphs 97-100, and page 15,

paragraph 143).

Thus, given the teachings of Gupta, it would have been apparent to one of

ordinary skill in the art to modify the teachings of Simonoff to disclose editing a

particular messaging entry in a first record. This would have allowed a user to use records as templates for message entries, Gupta page 5, paragraph 52.

11. In considering claims 2, and 10, Simonoff teaches receiving said edit at a messaging server communicatively connected via a network to a plurality of client messaging systems accessible to said users. See col. 25, lines 25-37.

12. In considering claim 3, Simonoff teaches receiving said edit at a particular client messaging system accessible to said particular user communicatively connected via a network to a plurality of client messaging systems accessible to said users. See col. 9, lines 46-57.

13. In considering claims 4, 11, and 17, Simonoff teaches allowing editing by said particular user, enabling said particular user to edit a particular messaging entry. See col. 18, lines 12-31.

14. In considering claims 5, 12, and 18, Simonoff teaches providing an interface to the particular user for entering the edit to the particular messaging entry. See col. 6, lines 38-56.

15. In considering claims 6, 13, and 19, although the teachings of Simonoff show substantial features of the claimed invention, they fail to expressly disclose: Submitting a request to edit the message entry.

Nevertheless Simonoff does teach: Approving at least one other user to edit the message entry. See col. 18, lines 23-25.

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Simonoff to show submitting a request to the at least one other user to approve the edit of the messaging entry. This would have provided an efficient means for approving users to edit the messaging entry, by only approving users to edit the messaging entry from the group of users who submit the requests.

Although the modified teachings of Simonoff show substantial features of the claimed invention, they fail to expressly disclose: Detecting an edit it a particular message after a conclusion of a messaging session.

Nevertheless, Gupta teaches: detecting an edit to a particular messaging entry by a particular user after a conclusion of a messaging session, (page 10, paragraph 100).

Thus, given the teachings of Gupta, it would have been obvious to a person of ordinary skill in the art at the time of the present invention to modify the teachings of Simonoff with the teachings of Gupta to show detecting the edit to the particular messaging entry by the particular user after a conclusion of the messaging session. This would have provided an efficient means for updating locally stored message

entries in servers associated with other users participating in the messaging session,

Gupta page 10, paragraph 100.

16. In considering claims 7, 14, and 20, the teachings of Simonoff provide a

means for receiving the approval with a digital signature corresponding to the at least

one other user, and storing the digital signature with the edit of the particular messaging

entry. See col. 18, lines 12-43.

17. In considering claims 8, 15, and 21, the teachings of Gupta provide a means

for updating a currently displayed record of a messaging session available to at least

one other user to distinguish an edit to the particular message entry from the particular

message entry as originally submitted, (page 10, paragraphs 97-100). One of ordinary

skill in the art would combine the teachings of Simonoff with Gupta for the same

reasons indicated in consideration of claims 1, 9, and 16.

18. Claims 22-30, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Simonoff.

19. In considering claims 22, 26, and 29, Simonoff teaches a method, system and

program residing on a computer readable medium for: Editing previously submitted

message entries from among a plurality of message entries in a messaging session,

wherein said messaging session facilitates conversation through said plurality of

message entries in a chat session, (col. 17, lines 39-59, and col. 18, lines 12-31);

Receiving editing authorization, submitting an edit to said previously submitted message

entry, such that a recording of said messaging session is adjusted according to said edit

to said previously submitted message entry, (col. 18, lines 12-31, and col. 25, lines 25-

37).

Although the teachings of Simonoff show substantial features of the claimed

invention, they fail to expressly disclose: Submitting a request to edit the message

entry.

Nevertheless Simonoff does teach: Approving at least one other user to edit the

message entry. See col. 18, lines 23-25.

Thus, it would have been obvious to one of ordinary skill in the art to modify the

teachings of Simonoff to show submitting a request to the at least one other user to

approve the edit of the messaging entry. This would have provided an efficient means

for approving users to edit the messaging entry, by only approving users to edit the

messaging entry from the group of users who submit the requests.

20. In considering claims 23 and 27, Simonoff teaches submitting said request to

edit a previously submitted entry from a client messaging system communicatively

connected via a network to a messaging server. See col. 17, lines 39-59.

21. In considering claim 24, Simonoff teaches submitting said request to edit a

previously submitted entry from a particular client messaging system communicatively

connected via a network to at least one other client messaging system. See col. 17, lines 39-59.

22. In considering claims 25, 28, and 30, Simonoff teaches in response to receiving approvals for said edit from at least one other user associated with said messaging session, storing said messaging session with said edit as a record accessible to said at least one other user. See col. 25, lines 25-37.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is (571) 272-3940. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HP/
4/14/05

ZARNI MAUNG
SUPERVISORY PATENT EXAMINER